

Serial No.: 10/722,574  
Atty. Docket No.: P66852US3

IN THE DRAWINGS:

Applicants have provided a replacement sheet of Figure 12 in which the reference numeral "2" has been changed to "82" to correspond with the specification. Entry thereof is requested.

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**REMARKS**

The Office Action mailed August 15, 2006, has been carefully reviewed and, by this Amendment, claims 1 and 19 have been amended. Claims 1-20 are pending. Claims 1 and 19 are independent. Claims 2-5 and 7-11 are withdrawn.

The Examiner objected to the drawings as containing reference numerals that do not correspond with the specification text. With this Amendment, Applicants have submitted a replacement sheet for Figure 12 in which the previous use of reference numeral "2" has been corrected to "82". With respect to the Examiner's statement regarding reference numeral "88" in Figure 12, and the corresponding specification text which referred to reference numeral "8", Applicants point out that this was corrected in the Response to Election Requirement filed on June 23, 2006 ("the June Response"), in which the specification text on page 13 was corrected to refer to reference numeral "88" in place of "8". Favorable reconsideration and withdrawal of the objection in view of the replacement sheet provided herewith and the June Response is requested.

The Examiner rejected claims 1, 6 and 12-20 under 35 U.S.C. 102(b) as being anticipated by WO 00/30575 to Pedersen et al. ("Pedersen").

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As set forth in amended claims 1 and 19, the present invention is directed to a kit for preparing a catheter for draining a human bladder. The kit includes a first proximal catheter section and a second distal catheter section which are arranged in a coextending fashion and define a longitudinally extending passage therein. When the kit is configured for storage, a tubular protective member surrounds the first catheter section, while at the same time the second catheter section is uncovered (see Figures 12 and 13; and page 13, lines 20-21). Without even addressing the remainder of the elements in claims 1 and 19, this structure, in which one of the catheter sections is surrounded by a tubular protective member while the other catheter section is uncovered as claimed, is not disclosed in the prior art.

Pedersen discloses a urinary catheter assembly with an integrated catheter applicator in the form of compartment 10. In a storage configuration, the catheter 1, which the Examiner has identified as the first catheter section is surrounded by a hose member 4 (see page 7, lines 5-8; page 8, line 34 to page 9, line 5). Fitted on the proximal end of the catheter 1 is a connector member 3, which the Examiner has identified as the second catheter section.

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Prior to use, and while the catheter 1 is sealed within the hose member 4 in the storage configuration, the connector member 3 is hermetically enclosed within the compartment 10 (see page 7, lines 24-29; Figures 1 and 7), the latter being sealed by the cover 11 (page 9, lines 1-3). Therefore, it is clear that when the first catheter section 1 is surrounded by the hose 4, i.e., by the tubular protective member, the second catheter section 3 is also fully covered. This complete enclosing of the catheter 1 and connector member 3 is necessary in view of the disclosed manufacture of Pedersen which requires that the package provide a liquid-tight seal to maintain the hydrophilic surface coating on the catheter in a ready-to-use status (see page 8, line 34 to page 9, line 8).

The presently claimed invention, by contrast, is directed to a catheter having first and second sections in which, in a storage configuration, the first section is covered by a tubular protective member while the second section remains uncovered. This arrangement is clear from Figures 12 and 13. As discussed in the specification on page 13, lines 10-12, Figure 12 illustrates the catheter when ready for insertion into the urinary tract. Figure 13, on the other hand, shows the kit with the tubular protective member attached to the catheter, i.e., in a storage configuration.

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Similar depictions, albeit for the other embodiments, of the storage versus ready-to-use configurations are evident from Figures 4 and 7, in which Figure 4 shows the kit as it is intended to be stored and shipped (page 11, lines 22-23), while Figure 7 shows the catheter exposed prior to use (page 12, lines 16-19). Similarly, in the embodiment of Figures 8-11, Figure 8 illustrates the storage configuration (page 12, lines 26-28) while Figure 10 shows the catheter ready for use. Accordingly, the language added to each of claims 1 and 19 specifying the arrangement of the catheter sections in a storage configuration is fully supported in the specification as filed and does not introduce new matter. To ensure literal correspondence with the specification, the text used in amended claim 1 and 19 has also been added to the specification at page 13 without adding new matter.

For at least the foregoing reasons, claims 1 and 19 are patentable over Pedersen. Claims 6, 12-18 and 20 are also in condition for allowance as claims properly dependent on an allowable base claim and for the subject matter contained therein. Favorable reconsideration and allowance of claims 1, 6 and 12-20 is therefore requested.

The Examiner provisionally rejected claims 1, 6 and 12-20 on the ground of non-statutory obviousness-type double patenting as

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being unpatentable over claims 1-26 and 54-65 of copending Application No. 10/184,081 or claims 1-21 of copending Application No. 10/537,014. Because the conflicting claims have not been patented, the rejection is provisional only. Accordingly, Applicants request deferral of the requirement for further response in connection with this obviousness-type double patenting issue until patentable subject matter has in fact been identified in at least one of the subject applications.

With the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any questions or comments, the Examiner is cordially invited to telephone the undersigned attorney so that the present application can receive an early Notice of Allowance.

Respectfully submitted,

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